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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,991

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Michael M. Evans

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07/13/2007

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EXAMINER

DANIELS, MATTHEW J

ART UNIT

PAPER NUMBER

1732

MAIL DATE

DELIVERY MODE

07/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/725,991	Applicant(s) EVANS ET AL.	
	Examiner Matthew J. Daniels	Art Unit 1732	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-60.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the enclosed response to arguments.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Response to Arguments

Applicant's arguments filed 18 June 2007 have been fully considered but they are not persuasive. The arguments appear to be on the following grounds:

- a) Johnson's mold is antithetical to any random application of medallions. Molds are designed to be used in advance, and are fixed and unchangeable. The molds provide regularity and predictability.
- b) There is no teaching or suggestion of applying the medallions "onto" the top surface of a substrate. The bodies of Johnson, B, are not applied onto a surface of concrete layer 5. The bodies are instead placed in cavities and then the layer of concrete is then applied.
- c) De Paoli is also silent to applying medallions onto the top surface of a substrate. The spatter inserts, by their name, are embedded into the terrazzo base. Thus, there is no application of medallions "onto" the top surface of a substrate.
- d) There is no proper suggestion or motivation for the combination of De Paoli and Johnson.
- e) The other cited references do not teach applying medallions "onto" the top surface of a substrate.

These arguments are not persuasive for the following reasons:

- a) This argument is directed to the randomness of subsequent parts produced in a repeated process. However, this argument is not commensurate with the scope of the claim, which requires only a method for decorating a (single) cementitious substrate. A random pattern is reproducible while retaining randomness of each formed article. Therefore, the use of a mold is not interpreted as being antithetical to randomness of a substrate.

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b,c,e) It is submitted that the relative movement between the layer of uncured concrete (5) and the articles which are interpreted to be medallions (B) reads on the instant claims, and alternatively that the limitation is still obvious over the cited references. Firstly, it is noted that the claim has been interpreted such that the substrate is uncured or at least partially uncured to provide “curing together” of the components. No particular degree of partial curing is recited, and a liquid cement mixture may also be interpreted to meet the broadest reasonable interpretation of “substrate”. In the Johnson method, the same relative movement between uncured portions is made, and it is asserted that no unexpected result is achieved by the relative orientation such that the medallions of Johnson (B) are on top such that they are placed “onto” layer 5.

Secondly, even if the pourable material of Johnson which forms layer 5 could not be interpreted to be a “substrate” when it is placed, the asserted difference is drawn to a difference in the order of steps of arranging the layer (5) with the concrete block (6) and placement of the medallions (B). Rearrangement of the order of steps disclosed by the prior art is generally considered to be prima facie obvious to the ordinary artisan. See MPEP 2144.04(IV)(C) and *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing

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ingredients is prima facie obvious.). In this case, Rubin is particularly relevant because it deals with rearrangement of steps in making a laminate, and the claimed method implicitly provides a laminate with a medallion placed onto a substrate. In the method of Johnson, rearrangement of the steps of arranging a layer (5) with a block (6) and application of medallions (B), providing the article shown in Fig. 3, appears to meet all limitations except for the “substantially random distribution”. It is submitted that there is no evident unexpected result following from the rearrangement, and that a random distribution would be obvious to increase aesthetic appeal.

Thirdly, even if *Rubin* were found inapplicable, De Paoli teaches pouring a substrate material, and then application of spatters, which are interpreted to be medallions (paragraph bridging columns 1 and 2). Although they ultimately form inserts, the spatters of De Paoli are inserted into the semi-plastic slab, and it is asserted that placement of the spatters onto the substrate is implicit in order that they be subsequently inserted. Any other method of providing a semi-plastic slab and then achieving inserted spatters which does not first require placement onto the slab or substrate is not apparent. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

d) The motivation provided does not appear to be particularly argued, and therefore still appears to be valid.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MJD 7/11/07


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7/14/07